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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,243	08/28/2001	Geoffrey B. Rhoads	P0423	6983

23735 7590 04/01/2003

DIGIMARC CORPORATION  
19801 SW 72ND AVENUE  
SUITE 100  
TUALATIN, OR 97062

EXAMINER

VU, VIET DUY

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 04/01/2003



Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/941,243

Applicant(s)

Rhoads

Examiner

Viet Vu

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on Mar 4, 2003

2a) ☒ This action is FINAL.

2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 7-21 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 7-15 and 19-21 is/are rejected.

7) ☒ Claim(s) 16-18 is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6) ☐ Other:

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**DETAILED ACTION**

**Art Rejections:**

1. The texts of 35 U.S.C. § 102(e) and 103(a) cited in the previous office action are hereby incorporated by reference.

2. Claims 7-10, 12-14 and 19 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Tow, European patent application No. 493,091.

Tow discloses a system and method for embedding linking data onto an image comprising:

a) receiving digital data corresponding to a graphic image (see col 3, lines 29-38),

b) steganographically encoding the image to hide a binary code representing a hyperlink pointer (col 3, lines 38-44 and col 4, lines 51-57),

c) printing the image on physical medium for distributing to user who can decode the address information and use the embedded hyperlink pointer to establish a link to the Internet (see col 4, lines 1-23).

3. Claims 11, 15 and 20-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tow.

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Per claims 11 and 20-21, Tow teachings are still applied as set forth in item 2 above. Tow does not explicitly teach using the address as index to a remote data structure. An official notice is taken that it is well known in the art to use URLs to index web pages at a remote web server.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize such conventional URL indexing for maintaining web pages at a remote web server because it would have enabled user to more easily surf the site.

Per claim 15, it would have been further obvious to one of ordinary skill in the art to apply Tow's teaching to embed digital information onto other types of image including a color image.

**Allowable Subject Matter:**

4. Claims 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Response to Amendment:**

5. Applicant's arguments filed on 3/4/03 with respect to claims 7-15 and 19-21 have been fully considered but they are not deemed persuasive.

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Applicant alleges that Tow's teaching of embedding hypertexts or hyperpointers in hardcopy prints is insufficient to anticipate or render the invention obvious.

This is not found persuasive. It is known in the art at the time the invention was made that a hyperlink pointer usually refers to a network location or network address including URL. Therefore, Tow's teachings are deemed meeting the claim limitation as discussed above.

**Conclusion:**

6. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is (703) 305-9597. The examiner can normally be reached on Monday through Friday from 8:00am to 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng An, can be reached on (703) 305-9678. The fax phone number for this Group is (703) 305-7201.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



VIET D. VU  
PRIMARY EXAMINER

V. Vu  
3/28/03